

### **REMARKS**

Reconsideration of the pending claims in view of the above amendments and following remarks is respectfully requested.

Claims 1, 2 and 3 are amended. Claims 4 and 5 are withdrawn.

Claim 1 is amended by inserting "hydrophilic" before "polymer", support for which can be found at page 2, lines 27-28 and page 3, line 20. Claim 2 is amended by replacing the phrase "a layer of" with "the" in order to improve the clarity of the claim. Claim 3 has been amended in order to improve the clarity of the claim by specifying that the blowing agent comprises at least two components, one of which is incorporated into the solution comprising a hydrophilic polymer, the other component of which blowing agent is dual melted into the solution immediately prior to coating, support for which can be found in the specification as originally filed.

Applicants thank Examiner Cameron for the indication of allowable subject matter and the acknowledgement that claims 2 and 3 would be allowable if rewritten or amended to overcome the rejection under 35 USC § 112.

### **Election/restriction**

In response to the Restriction requirement, the provisional election made on September 27, 2004 to prosecute the invention of Group I (i.e. claims 1 to 3) is confirmed. Claims 4 and 5 have accordingly been withdrawn.

### **Rejection under 35 USC § 112, first paragraph**

Claims 1-3 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. According to the Office Action, the claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Office Action states that the paragraph beginning with 4:8 is unclear and that it is not clear if the blowing agents are actually melted or molten, or what is meant by "bubbles in the melts" at the end of the paragraph.

The Office Action further states that it is not clear what is meant by “dual” melted. For at least the following reasons, Applicant traverses the rejection.

The term “melts” is commonly used in the coating arts to refer to a coating liquid, whether it is a *melt* or *solution* that is to be coated onto a support, and the skilled person would understand that to be the case. The term has found particular utility in the coating of solutions onto supports in the manufacture of photographic media but is equally applicable to coating methods in other fields. Similarly, the term “dual melted” is well known by the person skilled in the art to mean the addition of two *melts* or *solutions* immediately prior to coating in order that the *melts* or *solutions* are coated simultaneously. The term “bubbles in the melts” merely refers to bubbles that may have formed in the solutions by activation of the blowing agent. Accordingly, it is submitted that the manner and process are described in a clear and concise manner that would be understood by a person skilled in the art. Reconsideration and withdrawal of the rejection is therefore in order.

**Rejection under 35 USC § 112, second paragraph**

Claims 2 and 3 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. According to the Office Action:

- a) it is not clear what is meant in claim 2 by “dual” melted, and it is not clear if the blowing agent is actually melted or molten;
- b) it is not clear if the solution of claim 2 is the same or different from the solution of claim 1;
- c) it is not clear what is meant in claim 3 by “dual” melted and it is not clear if the blowing agent is actually melted or molten;
- d) it is not clear if the solution of claim 3 is the same or different from the solution of claim 1; and
- e) it is not clear if the “melt” of line 3 of claim 3 is the same or different from the “solution” of line 2. For at least the following reasons, Applicants traverse the rejection.

The meaning of the term “dual” melted, which gives rise to the rejections under a) and c) was explained in response to the 35 USC § 112, first paragraph rejection above where it was explained that the term is well known by the person skilled in the art to mean the addition of two *melts* or *solutions* immediately prior to coating in order that the *melts* or *solutions* are coated simultaneously. Claims 2 and 3 are therefore clear in this regard. The rejections under paragraphs b) and d) where it is stated that it is not clear if the “solution” of claims 2 and 3 is the same “solution” as that of claim 1 is overcome by amendment, by inserting “the” before “solution” in both claims 2 and 3 to clarify that the solution referred to in claims 2 and 3 is the same one as that of claim 1. The rejection under paragraph e) that it is not clear if the “melt” of line 3 of claim 3 is the same or different from the “solution” of line 2 is overcome by amendment of claim 3 to refer to “the solution” in both cases, clarifying that “solution” of line 2 is the same as the “melt” of line 3 of the previously presented claim 3.

Accordingly, it is submitted that the claims are in accordance with 35 USC § 112, second paragraph and particularly point out and distinctly claim the subject matter of the invention. For at least the above reasons, reconsideration and withdrawal of the rejection is in order.

**Rejection under 35 USC § 102 (b) over US 5,356,853 (Ueno et al)**

Claim 1 was rejected under 35 U.S.C. § 102(b) as allegedly anticipated by US 5,356,853 (Ueno et al). According to the Office Action, ‘853 teaches applying a foamed layer of polymer to a thermal transfer image receiving sheet (see Abstract, 5:3-58) by using a foaming agent that does not foam until after application to the sheet (12:30-50, 19:42-53). For at least the following reasons, Applicant traverses the rejection.

US 5,356,853 is concerned with a thermal transfer image receiving sheet comprising a substrate sheet and dye receptor layer disposed on at least one surface side of the substrate sheet, wherein the dye receptor layer has been formed on the substrate sheet by superposing the substrate sheet onto a receptor layer transfer film comprising a substrate film and the dye receptor layer disposed on one surface side thereof which is peelable from the substrate film, so that the receptor layer transfer film is bonded to the substrate sheet to form a laminate,


- and peeling the substrate film from the laminate. The thermal transfer sheet also includes a substrate film, an intermediate layer disposed on the substrate film and a dye layer disposed on the intermediate layer (see Abstract). The thermal transfer sheet of '853 is mainly characterised in that bubbles are incorporated in at least one of the dye layer and intermediate layer (column 19, lines 42-46). The dye receptive layer comprises a binder resin, examples of which are listed at column 10, line 65 to column 11, line 10 and include, for example, polyolefin type resin, halogenated polymer, vinyl type polymers, polyester type resin, polystyrene type resins, polyamide type resins etc. The optional adhesive layer typically use adhesives for dry laminating such as two component type polyurethane type adhesive or epoxy type adhesives, vinyl acetate resins, polyester type resins, etc (column 11, line 66 to column 12, line 6). The intermediate layer typically consists of a polyurethane resin, acrylic resin, polyethylene type resin, butadiene rubber, epoxy resin etc (column 19, lines 32-38). The foaming agents that may be used in '853, which are listed at column 19, lines 57-61 all require high temperatures for decomposition to begin, as is illustrated in the Examples.

Claim 1 relates to a method of making a material comprising the steps of coating a support with a solution comprising a *hydrophilic* polymer and at least one blowing agent, activation of the blowing agent being prevented until after coating.

None of the resins described in '853 for use in the dye receptor layer, adhesive layer or intermediate layer are hydrophilic polymers and there is no teaching that would lead the skilled person to coat a support with a solution comprising a *hydrophilic polymer* and at least one blowing agent nor of any benefit of doing so. It is submitted, therefore, that claim 1 is novel and inventive over '853. For at least the above reasons, reconsideration and withdrawal of the rejection is in order.

In view of the foregoing remarks, reconsideration of the above-identified patent application is respectfully requested. Prompt and favourable action by the Examiner is earnestly solicited. Should the Examiner require anything further, the Examiner is invited to contact Applicants' representative.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.